

ORIGINAL

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

Applicants: Robertson, S.
Serial No.: 09/324,601
Title of Invention: System and Method for Providing Electronic Multi-Merchant Gift Certificate and Contribution Brokering Services Over a Distributed Network
Filing Date: 06/02/1999
Group Art Unit: 3625
Examiner: Fadok, M.
Attorney Docket No.: ROBERT.P001



Seattle, Washington 98109
July 7, 2006

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SUPPLEMENTAL BRIEF OF APPELLANT

The Examiner has suspended the present appeal and reopened prosecution of this case in a non-final office action dated 5/9/2006 rejecting claims 23-37 over newly cited Gillen reference as new grounds for rejection. Applicant's arguments addressing these alleged new grounds for rejection are set forth in this supplemental brief. As this is a supplemental brief, no brief fee is believed to be required.

REAL PARTY IN INTEREST (37 CFR 1.92(c)(1))

Same as in original brief.

RELATED APPEALS AND INTERFERENCES (37 CFR 1.92(c)(2))

CERTIFICATE OF MAILING (37 CFR 1.8a)

I hereby certify that this paper (along with any paper referred to as being attached or enclosed) is being deposited with the United States Postal Service on the date shown below with sufficient postage as first class mail in an envelope addressed to the Commissioner of Patents and Trademarks, Washington, D. C. 20231.

July 7, 2006


Patrick Dwyer

1-8PCRT.INS

Same as in original brief.

STATUS OF CLAIMS (37 CFR 1.92(c)(3))

Same as in original brief, except that Applicant was notified in an office action dated 12/29/2005 that permission had been granted the Examiner to suspend the case for 6 months while a reference relevant to the examination issued; this was followed by a non-final rejection of Claims 23-37 in an office action dated 5/9/2006.

STATUS OF AMENDMENTS (37 CFR 1.192(c)(4))

There have been no amendments filed responsive to the 5/9/2006 Non-final Rejection; there have been no interviews with the Examiner since the Final Rejection appealed from.

SUMMARY OF THE INVENTION (37 CFR 1.192c5 & 37 CFR 41.37c1v)

Same as in original brief.

ISSUES (37 CFR 1.192(c)(6))

Same as in original brief, plus

3. Are Claims 23-37 allowable over Gillin (7,010,512) citation under 35 USC 102(e)?

GROUPING OF CLAIMS (37 CFR 1.192(C)(7))

With respect to any of their rejections no claims stand or fall together.

SUPPLEMENT ARGUMENT (37 CFR 1.92(c)(8))

Applicant repeats the arguments of the original brief as if fully set forth.

III. Claims 23-37 Are Allowable and Not Anticipated by Gillin.

Claims 23 - 37 stand rejected under 35 USC §102(e) as being anticipated by Gillin et al., U.S. Patent No. 7,010,512 (hereafter Gillin).

Applicant submits that the Gillin reference does not represent new grounds for rejection at all. Gillen is at best a reference supporting the grounds for rejection that the Examiner already

set forth in previous office actions based upon a set of two articles listed as Webcertificate 1 and 2. In fact it is believed that Gillen is nothing more than the patent that incorporates the disclosures of the previously cited WebCertificate documents. All of these grounds of rejection by the Examiner have been extensively addressed in the original Brief of Appellant. It would even appear that the Examiner, in merely quoting Gillin's abstract, has yet to point out where the elements of the various claims on appeal supposedly have their correspondence to the teachings of Gillin. In any event, the Gillin reference, even after careful review by the undersigned, fails to anticipate any of the claims on appeal.

In fact, as already asserted with respect to the WebCertificate documents in Applicant's original brief, the Gillin reference actually teaches away from the elements of the claims on appeal. For instance, Claim 23 clearly requires "a gift certificate authority site connected to the plurality of merchant sites, the gift certificate site including a user database and a merchant database, each database containing authentication information as to respective users and merchants...[Underlines added]" A programmatic infrastructure is disclosed and claimed by Applicant, establishing direct connections to merchants. By contrast, Gillin discloses that, "unlike with the issuer of conventional gift certificates or gift checks, the issuer operating in accordance with the invention does not need to establish any form of relationship with merchants who will accept payment from the recipient [of a gift] according to the invention. [emphasis added]" (Gillin, Col. 5, Ln. 54-58) Gillen's merchants are only integrated into the system through methods common to any credit card system.

In fact, the system of Gillin offers, in substance, nothing more than the sale of a temporary credit card from a stockpile obtained from one or more existing credit card providers, teaching in the detailed description of Fig. 1, "...Transfer instrument issuer 10 provides the recipient 40

with an account number and amount or limit that can be used at any merchant(s) accepting the same type of accounts where cards are issued...any merchant (on line or mail order/telephone order) that accepts card type accounts where physical cards have issued and been provided to, for example, Visa, Mastercard, American Express, JCB, Eurocard, etc.”(Gillin et al., Col. 7, Ln. 18-21 and 25-33)

Gillin neither needs nor suggests the “merchant database, each database containing authentication information as to respective users and merchants” required by Claim 23. In fact, such a database would not be feasible with millions of merchants world wide currently taking credit cards of the type taught by Gillin as part of the system. Gillin not only does not teach the “merchant databases” of Claim 23, it teaches away from it pointedly, as no such merchant database would be needed if all transactions are simply handled by established suppliers of credit cards: “From the perspective of the merchant, the charge is processed, and funds are received, in the normal manner using the merchant’s acquiring bank, through the normal cardholder association clearance/settlement process.”(Gillin, Col. 22, Ln. 8-12) The merchant authentication required by Claim 23 as part of the Applicant’s gift certificate authority site is not in any way taught by Gillin. As taught by Gillin, the merchants are not even actually integrated into the system through any screening or assignment of entity identification beyond the conventions of existing credit card systems.

In addition, Claim 23 requires, “a plurality of merchant sites connected to the distributed network, each merchant site running at least one application...” The merchant site application is defined in Applicant’s specification: “With reference to FIG. 1, each Merchant site additionally includes a Gift Certificate Agent 64, which authenticates an electronic gift certificate with the Gift Certificate Authority. The Gift Certificate Agent 64 server components are preferably in the form

of software modules, which include the necessary logic for sending the items in an encrypted format to the Gift Certificate Authority 80.” Thus, it can be seen that Claim 23 requires the installation of a software module on a merchant site expressly for the purpose of communicating directly with the Gift Certificate Authority Site and server application. No such element is taught by Gillin. In fact, Gillin pointedly teaches away from such an element: “Furthermore, merchants do not need to follow special redemption procedures or need any additional infrastructure access to accept the transfer instrument if they can accept payment for similar types of accounts for which cards have issued and been physically provided to the cardholder.” (Gillin, Col. 5, Ln. 64-66 to Col. 6, Ln.1-2) Gillin suggests none of the claimed robust range of utility and control; it’s just another online credit card scheme.

Clearly Claim 23, and claims 24 - 28 which include all the elements of Claim 23, are not taught by Gillin. The claimed interaction between the gift certificate provider and the participating merchants is distinctive and provides significant utility and control of use by users of Applicant’s system and method. The restrictions on the use of the gift certificate of Claims 24 and 28, the ability to timely track, report and search transactions of Claims 25 and 26, the level of anonymity provided the purchaser within Claim 27, all further defined in the specification, are not possible with a system and method that utilizes the existing credit/bank/charge card infrastructure, which is pointedly not configured to perform such functions. In fact, the current credit card system is configured to perform oppositely.

For example, in regard to Claim 24, the only restrictions that may be placed on the use of the temporary credit cards of Gillin are those commensurate to an ordinary credit card purchase: *i.e.* a maximum dollar limit, “delivery date, starting date, expiration date, duration or ‘life’ of the transfer instrument...”(Gillin, Col.17, Ln. 66 to Col.18, Ln.2) This is not the range of

restrictions claimed and further described in Applicant's specification. The "transfer instrument" of Gillin could never restrict where purchases might be made as Applicant's system and method does, because it can be used wherever a credit card can be used. This is freely admitted in Gillin: "...the purchaser 236 may have the further option of recommending a particular merchant...however, the recipient need not use the transfer instrument with the merchant(s) recommended." (Gillin Col. 18, Ln.44-52)

In regard to Claims 29 and 33, Gillin teaches that, in the transfer instrument purchase process, after the purchaser's payment has been authorized or cleared, "An account number entry for a payment card account obtained from the issuing bank 20 is added and/or assigned in the database 222 and fields are populated in accordance with the information received [Emphasis added]." (Gillin, Col.19, Ln.1-4) Gillin assigns the purchaser one of their stockpile of credit card numbers, thereby again teaching away from creating a gift certificate with unique identifier, under the control of the Gift Certificate Authority Site of Applicant's system and method.

In regard to Claims 30, 31 and 32, Gillin again teaches away from Applicant's claims, because restriction of the use of a credit/debit/charge card cannot be made. Without the claimed control over the gift certificate, the shipping address for purchases made with the gift certificate cannot be predetermined as required by Claim 30 and the restrictions described in Claims 31 and 32 cannot be applied (see Gillin, Col. 18, Ln. 44-52). Clearly, Gillin does not teach the method of Claims 29-32.

In regard to Claim 34, Gillin does not teach nor suggest the use of a gift certificate authority site as claimed. The final step of Claim 34, "merchant site communicates over distributed network with gift certificate authority site to authenticate the user gift certificate and complete user purchase of selected goods or services," is not part of the methods taught by Gillin.

As argued above, Gillin does not teach an interaction between the merchants and a gift authority site; in fact it teaches away by teaching the necessary step of running all the transactions through “Acquiring Banks”. “On the merchant’s side of retail transactions, merchants 210 who wish to accept payments using the cards register with a bank 212 affiliated with the card association 200...When a purchase transaction is made by the cardholder 103, typically the merchant 210 seeks authorization using an infrastructure 214 set up by the card association 200...”(Gillin, Col. 9, Ln.5-17).

As to Claims 35, 36 and 37, Gillin fails to present any teaching or suggestion whatever as to contribution management or brokerage, and the Examiner has made no reference at all to these claims as to alleged corresponding elements in Gillen. In fact, while a Gillen-style card itself could be donated to a charity, its usefulness to the charity would be severely limited to whether the card had a very large value or not; otherwise, the charity would be constrained to use the card limits of dozens or hundreds of cards to effect any significant purchases for its enterprise. In contrast, Applicant’s system allows for direct deposit to a beneficiaries bank account, so that all contributions effected through the claimed system are aggregate and fungible for any particular charity (see for example application page 17, line 6).

It appears that the Examiner has made no attempt to address arguments presented by Applicant in his original brief regarding the distinction between the appealed claims and a system based upon existing infrastructures for temporary credit cards, even though the previously cited articles, Webcertificate 1 and 2 were based upon just such a system and such arguments were presented by Applicant in the original brief. The very Gillin Abstract which the Examiner presents as the only support for an alleged correlation between Gillin and Applicant’s claims actually begins, “A method is disclosed involving acquiring a plurality of charge accounts. The

accounts are of a type normally issued with an associated physically producible card which may be presented as evidence of an existing charge account..."(Gillin, Abstract). Gillen 'charge accounts' just have nothing to do with the disclosed and claimed gift certificate system.

Therefore none of the appealed claims are anticipated by Gillin, and Applicant requests that all of these rejections be reversed, as well as all previous rejections addressed in Applicant's original brief.

The claims on appeal have been set forth in the Appendix to the original brief.

Respectfully submitted,



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REQUEST FOR REINSTATEMENT OF APPEAL

Reinstatement of this appeal is hereby requested, and is accompanied by a supplemental appeal brief as set forth in Rule 1.193(b)(2), filed herewith. The Examiner has suspended the present appeal and reopened prosecution of this case in a non-final office action dated 5/9/2006 rejecting claims 23-37 over newly cited Gillen reference as new grounds for rejection. Applicant's arguments addressing these alleged new grounds for rejection are set forth in the supplemental brief.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Patrick Michael Dwyer".

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CERTIFICATE OF MAILING (37 CFR 1.8a)

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